

Amendment
Serial No. 10/522,186
Attorney Docket No. 043157

REMARKS

Claims 1 and 9 are pending in the present application and are rejected. Claims 1 and 9 are herein amended. New 10-12 are added herein. No new matter has been added.

Applicants' Response to Claim Rejections under 35 U.S.C. §112

Claims 1 and 9 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is the position of the Office Action that claims 1 and 9 are indefinite because it is unclear what the term "both" refers to in claim 1, and because claim 9 does not recite formula (1). Accordingly, Applicants herein amend claims 1 and 9 in order to correct these errors. Applicants also note that new claims 10-12, discussed below, are drafted to clarify the term "both." Favorable reconsiderations is respectfully requested.

Applicants' Response to Claim Rejections under 35 U.S.C. §102

Claims 1 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by Mujumdar et al., Indian J. Chem., vol. 10, 677-680 (1972).

Claims 1 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by Shen et al., Chinese Pharmaceutical Journal (Taipei), vol. 49, No. 5-6, 1997, pp. 285-286.

It is the position of the Office Action that Mujumdar discloses the compound taxiresinol. It is the position of the Office Action that Shen discloses the compound taxiresinol (abstract, line

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2, page 285 and compound 7, page 288) exhibiting cytotoxicities. The Office Action states that the compound disclosed in Mujumdar and Shen anticipates the compositions of claims 1 and 9 comprising taxiresinol. The Office Action further states that the descriptions of “hypoglycaemic agent” (claim 1) and “hepatoprotective agent” (claim 9) are interpreted as intended use limitations and are not given any patentable weight because they are not deemed to limit the claims. The Office Action therefore concludes that the prior art’s description of taxiresinol anticipates the compositions comprising taxiresinol.

In response, Applicants herein amend claims 1 and 9 to recite functional language, and respectfully submit that neither Mujumdar nor Shen discloses or suggests such functional features. Accordingly, Applicants respectfully submit that, in view of these amendments, a rejection for lack of novelty is improper. Additionally, Applicants respectfully submit that, in view of Mujumdar or Shen, one having ordinary skill in the art would not have been motivated to achieve the result of decreasing in blood glucose levels and inhibiting an increase in levels of glutamic-pyruvic transaminase and glutamic oxaloacetic transaminase in bloom serum. Favorable reconsideration is respectfully requested.

Additionally, Applicants note that Shen does not disclose taxiresinol exhibiting cytotoxicities. The title of Table 1 of Shen is “Cytotoxicities of Compounds 1-4.” Table 1 does not include taxiresinol, which is compound 7. The abstract on page 285 merely states that taxiresinol 7 was isolated from a specific plant. The cytotoxicity of lignans is discussed at page 289, lines 10-20. However, taxiresinol does is not discussed in this passage. Therefore, Applicants respectfully submit that experiments for cytotoxicity using taxiresinol were not

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carried out by Shen. Accordingly, for at least the above reasons, Applicants respectfully submit that claims 1 and 9 are patentable over the cited art. Favorable reconsideration is respectfully requested.

Furthermore, Applicants herein add method claims. Please see new claims 10-12. No new matter has been added. Applicants respectfully submit that neither Mujumdar nor Shen discloses or suggests the recited methods. Favorable consideration is respectfully requested.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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